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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF APPEALS

In re Application of

Robert Skvorecz :

Reissue of US Patent 5,996,948

EXAMINER: Tan Le

SERIAL NO: 09/772,278 :

: GROUP: 3632 :

FILED: March 15, 2001 :

FOR: WIRE CHAFING STAND :

REPLY BRIEF FOR APPELLANT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAIL STOP APPEAL REPLY BRIEF - PATENTS

SIR:

All necessary fees in connection with this Reply Brief should be deducted from Deposit Account No. **01-1944**.

This reply brief is filed under 37 CFR 1.193(b)(1) in response to the Examiner's answer dated December 9, 2005.

Robert Skvorecz, as appellant, and as is set forth in appellant's brief is the real party in interest.

(2) Status of Claims:

The statement of the status of claims in paragraph (3) of the brief is correct and is hereafter restated as follows:

Claims 1-7 are pending in the application with claims 1,2 and 5 rejected under 35 USC102(b) and with claims 1-5 and 7 also rejected under 35 USC 251. Claim 6 is allowed.

(3) Grounds of rejection to be reviewed on Appeal:

The statement of the grounds of rejection as set forth in paragraph (9) of the brief is correct and hereafter restated as follows:

1. Claims 1, 2 and 5 stand finally rejected under 35 USC 102(b) “as being fully anticipated by US Patent 5,503,062 (Buff IV)”.

2. Claims 1- 5 and 7 stand finally rejected under 35 USC 251 “as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based”.

3. Claim 6 is an independent claim which is identical to claim 6 in the issued patent and has again been re-allowed.

(4) Argument

A. In paragraph (10) of the Examiner’s Answer, the Examiner has renewed the final rejection of claims 1, 2 and 5 under 35 USC 102(b) as being fully anticipated by US Patent 5,503,062 (Buff IV) using a copy of Figure 2 of Buff IV as an

illustration. The illustration is included in the Examiner's Answer on page 7 thereof as an unmarked exhibit and is intended to substantiate the rejection of the claims under 35 USC 102(b) and to provide support for new legal arguments which were not earlier presented. A copy of the illustration of Figure 2 of Buff IV from page 7 of the Examiner's Answer is identified hereto as "Exhibit 1" in the annexed "Evidence Appendix". Exhibit 1 includes the wording added by the Examiner to Figure 2 and additional wording added by Appellant to crystallize the issue under appeal with respect to the rejection of the claims under 35USC102(b).

First, the Examiner argues on page 5 of the Examiner's Answer that the definition of the term "offset" as set forth in column 2 lines 7-8 or part thereof is functionally narrative and that the functional requirement is not to be read into the claims as a limitation thereof. To the contrary, the term "offset" is defined in the specification and claims "as an indent in each wire leg for laterally displacing each leg relative to the point of attachment" and this definition is repeated in column 2 lines 7-8 as well as in column 4 lines 13 -14 and in claim 1 as indicated below. The doctrine permitting an applicant to be his own lexicographer is well established in patent law and no case law has been cited by the Examiner or known to appellant permitting an Examiner to limit the definition to only certain selected words in the definition not relating to function or to a single noun. By excising from the definition what the Examiner interprets as being "functionally narrative" constitutes reformulating a new definition contrary to well established law and inconsistent with the stated definition.

Moreover, claim 1 also repeats the definition in the last four lines which reads as follows:

--comprising a plurality of offsets located either in said upright sections of said wire legs or in said first [upper] rim for laterally displacing each wire leg relative to said first [upper] rim to facilitate the nesting of a multiplicity of stands into one another without significant wedging---

Accordingly, the allegation of the Examiner that the language “for laterally displacing each wire leg relative to said first rim” should not be construed as part of the definition of the term “offset” or should not to be construed as a limitation of the claim contradicts the definition which mandates this requirement. The additional argument of the Examiner that this wording should be given no patentable weight because the Examiner deems it to be functional is species for the reasons given above and because it directly contradicts the MPEP 2173.05 which requires a claim to be examined based upon the meaning stated in the specification. This is set forth in the MPEP 2173.05 as follows: “When the specification states a meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant’s invention and its relation to the prior art”. The Examiner has apparently disregarded the MPEP 2173.05 and is instead attempting to establish new law with regard to this issue confusing it with the requirement for “means...for” terminology in a claim.

Secondly, appellant has pointed out in the brief and wishes again to emphasize that the rejected claims require each wire leg (emphasis added) to be laterally displaced relative to the first rim. Not only is this limitation specified in claim 1 it is also part of the definition of the term “offset”. As pointed out in the illustration of Figure 2 of Buff IV (Exhibit 1) the Examiner in his own wording points to what is alleged

to constitute "offsets" in the upper section of the wire legs at both opposite ends of the member. However, the Examiner has clearly elected to disregard the wire legs 50 located on the lateral sides which are also part of the member as is shown in the illustration. The wire legs 50 which the Examiner has disregarded extend to the rim 40 and do not have the alleged "offsets" 52 or any other kind of offsets. Therefore, each wire leg cannot be laterally displaced relative to the first (upper) rim as is required in claim 1. Clearly all of the limitations in the claim are not fully met by Buff IV. In fact appellant submitted a Declaration under 35USC 132, which is not of record since the Examiner considered the Declaration to be untimely filed, to prove to the Examiner that because of missing "offsets" in the lateral wire legs 50 in Buff IV (disregarded by the Examiner) it is physically impossible for Buff IV to be capable of performing the alleged intended use of laterally displacing each wire leg as claimed. Appellant requests the Board independent of the Declaration to take Official Notice of the impossibility for Buff IV to perform this alleged intended use with regard to each wire leg as called for in claim1. It is not necessary to be an expert in the art to fully appreciate this. This point is elaborated upon at great length in appellants brief.

Third, the so called "offsets" 52 in Buff IV, as shown in the illustration ("Exhibit 1") and as explained in Buff IV, are positioned so that they lie over the rim 40 apparently to provide support for the lip 44 of the pan 30 which is placed into the bottom member. However, as is shown in Exhibit 1, by positioning the so called "offsets" 52 over (emphasis added) the first rim 40 the so called offsets 52 cannot by definition be located "in said first [upper] rim" as called for in claim 1. The Examiner in the Examiner's Answer in the last paragraph of page 6 appears to be misinterpreting the

last four lines of claim 1 which requires the “offsets” (themselves) to be located **“either in the upright section of the wire legs or in the first rim”**. Locating the offsets in the first rim as opposed to the upright section of the wire legs constitutes the alternate embodiment of the subject invention referred to in column 5 of the reissue application last paragraph. In each case the offsets cause a lateral displacement to occur of each wire leg relative to the first rim. All of the additional arguments of appellant relating to the rejection of the claims under 35USC 102 as set forth in appellants brief is incorporated herein by reference. Hence, the allegation of the Examiner that Buff IV meets all of the limitations of claim 1 is without merit and the rejection of the claims under 35USC102(b) should be reversed.

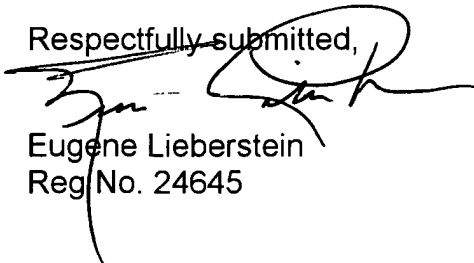
B. As to the final rejection of the claims “as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based” under 35 USC 251 appellant relies upon the arguments in appellants brief which are incorporated herein by reference. However, appellant wishes to add the point that the burden of proof to substantiate the existence of an improper recapture under 35 USC 251 rests with the Examiner and is not shifted to appellant simply because an amendment was filed by applicant during the prosecution of the parent case. The Examiner has correctly pointed out that the record of the application shows that an amendment had been filed during the prosecution of the application. However, this should not by itself constitute a showing that subject matter has been surrendered during the prosecution of the application which relates to the broadening aspect of the reissue claims. The Examiner repeatedly makes the conclusive statement that subject matter has been surrendered during the prosecution

of the application which relates to the broadening aspect of the reissue claims. This naked statement accompanied by a statement showing the amendment of record made during the prosecution of the application should not by itself constitute a showing that subject matter has been surrendered which relates to the broadened reissue claims and does not of itself warrant application of the recapture rule. The recapture rule should not automatically apply because an amendment was filed during prosecution or shift the burden to applicant to prove that recapture should not apply because of the filing of an amendment. The Examiner has not satisfied the burden of proof to warrant application of the recapture rule other than to repeatedly state over and over and over again that the broadening aspect of the reissue claims relates to claimed subject matter that applicant previously surrendered during the prosecution of the application.

Conclusion

For all of the above reasons taken in conjunction with appellant's brief the rejection of the claims should be reversed.

Respectfully submitted,


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Mailing Certificate

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313, MAIL STOP REPLY BRIEF – PATENTS, on January 20, 2006.


Lorraine Felicetti

